

Remarks/Arguments:

Opening Remarks

Applicants appreciate the time and courtesy extended by the Examiner during the Examiner Interview conducted by telephone on Thursday, February 4, 2010. The Interview was attended by Brett J. Rosen (Patent Agent, Reg. No. 56,047) and Examiner Forrest M. Phillips. During the Interview, the features of claims 7 and 17 as well as the details of the cited references were discussed.

The Office Action Summary Page indicates that the specification stands objected, however, the Office Action does not describe the details of the objection. Clarification is respectfully requested.

Claim Status

Claims 7-9, 12-14 and 17 are currently pending. Select features of claims 11 and 16 have been incorporated into claim 7. Claims 11 and 16 have been cancelled without prejudice or disclaimer of the subject matter thereof. Claims 7 and 17 have been amended to incorporate features of the second connection pipe which are shown in FIGS. 1 and 2 and described in the originally-filed specification. No new matter has been added.

Claim Rejections Under 35 U.S.C. §103

Claims 7-9, 12-14, 16 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent App. Pub. No. 2004/050618 to Marocco in view of DE 20115656 to Faurecia and further in view of U.S. Patent No. 4,689,952 to Arthur. Claims 11 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Marocco in view of Faurecia and further in view of U.S. Patent No. 5,907,134 to Nording. Applicants respectfully request reconsideration of the rejection of these claims and respectfully submit that these claims are patentable over the cited references for the reasons set forth below.

Page 3 of the Office Action contends that "[w]hile Marocco does not disclose expressly wherein the connection pipes are removably mounted, it would have been obvious to one of ordinary skill to make the pipe removable, *since it has been held constructing a formerly integral structure in various elements involves only routine skill in the art. Nerwin v. Erlichman*, 168 USPQ 177, 179." **Applicants respectfully disagree and submit that no such**

language or holding appears in the *Nerwin v. Erlichman* decision, which is enclosed herewith. Applicants offer a brief synopsis of the *Nerwin* decision: the patentee argued that a single element can not be used to meet two positively stated and separately claimed elements. The court disagreed and stated that "the mere fact that a given structure is integral does not preclude its consisting of various elements" ... [and, citing *Reed v. Edwards*,] "the same element may be relied upon for performing two functions." *Nerwin* does not stand for the proposition that "*constructing a formerly integral structure in various elements involves only routine skill in the art*," as stated in the Office Action. Based upon that point alone, Applicants respectfully request reconsideration of the rejection of the pending claims. Moreover, with respect to claim 17, because the Office Action has not disclosed all of the individual components of Applicants' claimed invention and the *Nerwin* decision fails to overcome that deficiency, Marocco's integral exhaust system does not meet all of the assembly steps that are recited in claim 17.

Applicants also direct the Examiner's attention to *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983), which is cited in M.P.E.P. 2141.02. In *Schenck*, the Federal Circuit held that, in viewing the invention as a whole, integrating a formerly multi-component structure was not obvious.¹ Specifically, the court held that "in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." Applicants respectfully submit that the claimed invention, as a whole, would not have been obvious in view of the cited references. As discussed in Applicants' specification, "by separating the two exhaust lines in the area of the end muffler, the individual exhaust line can be assembled as a preassembled constructional unit in order to then complete it on the vehicle to form the entire exhaust system. By separating the U-shaped entire exhaust system in the area of the end muffler, a transport of the

¹ M.P.E.P. 2141.02: In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) (Claims were directed to a vibratory testing machine (a hard-bearing wheel balancer) comprising a holding structure, a base structure, and a supporting means which form "a single integral and gaplessly continuous piece." ***Nortron* argued the invention is just making integral what had been made in four bolted pieces, improperly limiting the focus to a structural difference from the prior art and failing to consider the invention as a whole.** The prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure. "Because that insight was contrary to the understandings and expectations of the art, the **structure effectuating it would not have been obvious to those skilled in the art.**" 713 F.2d at 785, 218 USPQ at 700 (citations omitted).).

preassembled constructional unit also becomes possible..." (see paragraph 6 of Publication No. 2009/0020359). The foregoing advantages are not found in the cited references.

Additionally, independent claim 7 recites features that are neither disclosed nor suggested by the cited references, namely, a "[d]ouble-flow exhaust system for an internal-combustion engine comprising: two exhaust-gas-carrying pipes that are configured to receive gasses produced by the internal-combustion engine, at least one muffler and catalyst housing associated with each exhaust-gas-carrying pipe, each muffler including at least two ports extending therefrom, wherein each port of a muffler is provided for either receiving exhaust gases from another muffler or directing exhaust gases out of the muffler, a first removably mountable connection pipe for fluidically connecting the mufflers of the exhaust-gas-carrying pipes, wherein the first removably mountable connection pipe is a T-pipe that includes two inlet ports that are oriented along a common axis and an outlet port that is oriented substantially perpendicular to the common axis of the inlet ports, each inlet port of the first removably mountable connection pipe being configured to be removably mounted to a single port of a respective muffler to receive exhaust gases from the muffler, and said outlet port of said first removably mountable connection pipe being configured to discharge the exhaust gases to a location outside of the internal-combustion engine, and a second connection pipe for fluidically connecting the mufflers of the exhaust-gas-carrying pipes, wherein the second connection pipe includes two connecting pieces each extending out of a respective muffler housing, wherein end faces of the connecting pieces are separated by a gap that is covered by a removably mountable joint sliding sleeve that is directly connected to the connecting pieces."

With regard to the second connection pipe recited in claim 7, page 5 of the Office Action contends that it would have been obvious to combine the teachings of Nording to use a joint sliding sleeve connection with the second connecting pipe of Morocco as modified to provide a sealed joint that allows for thermal expansion and misalignment. Applicants have amended claim 7 to recite "end faces of the connecting pieces are separated by a gap that is covered by a joint sliding sleeve that is directly connected to the connecting pieces." Nording's sliding fit 16, which the Office Action characterizes as analogous to Applicants' joint sliding sleeve, does not cover a gap that is disposed between end faces of two connecting pieces of a connection pipe. To the contrary, the end face of Nording's pipe section 12 overlaps the end face of pipe section 14. Also, Nording's sliding fit 16 is not "directly connected" to pipe section 14, because

Nording's sliding fit 16 permits axial translation of the pipe sections 12 and 14 to accommodate thermal expansion of the pipe sections.


In addition to the arguments presented in the last response regarding the first removably mountable connection pipe recited in claim 7, Applicants respectfully submit that none of the cited references disclose or suggest "two inlet ports that are oriented along a common axis." The axes of Arthurs inlet ports 34 and 36 and Faurecia's inlet ports 26a and 26b are separated by a distance, as opposed those ports sharing a common axis.

Accordingly, because claims 7 and 17 each includes limitations that are neither disclosed nor suggested by the cited references, *prima facie* obviousness cannot be established based on those cited references. Claims 8, 9 and 12-14 are dependent upon claim 7, and therefore should also be allowed at least as being dependent upon an allowable base claim. Reconsideration of claims 7-9, 12-14 and 17 is respectfully requested.

Conclusion

In view of the amendments in the claims and the remarks set forth above, Applicants respectfully submit that this application is now in condition for allowance, which action is respectfully requested. If the Examiner believes an interview will advance the prosecution of this application, it is respectfully requested that the Examiner contact the undersigned to arrange the same.

Respectfully submitted,



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Encl: *Nerwin v. Erlichman*, 168 USPQ 177

Dated: February 8, 2010

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means "steerable" which is definitive of the Miller et al. device.

We also note that this claim is drawn so broadly as to include gyroscopic type accelerometers.

The other method claims are likewise deemed to find response in the references.

[1] Claims 6, 7 and 10 use the term "comprising" to introduce the claimed structure, which means to us that the device covered by these claims may involve many more elements than those positively recited therein as, for example, many gyroscopes.

The structure positively recited in the claims finds response in either reference. The term "sole" used in the claims is not a structural limitation, but is in the nature of a negative limitation.

Accordingly, we will sustain the prior art rejection of these claims.

As pointed out above, appellants have disclosed no structural support for the apparatus claims 6, 7 and 10.

The device described in the specification and shown in the drawing covers any kind of accelerometer, any type of a control loop, any kind of actuator elements and any kind of a signal processing network. Each of these elements, mechanical or electrical, are different in structure and operation, require different interconnections and produce different results.

In the absence of a specific identification or description of each of the aforesaid elements the routineer is not taught how to practice the invention, workers in the art have no knowledge as how to proceed with future developments in the art without infringing the claims and courts lack any knowledge as to what they are dealing with in interpreting the claims.

[2] The pertinent case law requires appellants to disclose apparatus for practicing the method where, as in this case, the apparatus is not obvious to a routineer.

Accordingly, we reject claims 1, 2, 6, 7 and 10 for lack of disclosure, 35 U.S.C. 112, under the provisions of Rule 196(b).

We make no comments with respect to allowed claims 3, 4, 5, 8 and 9 in the light of *Watson v. Bruns*, 99 U.S. App. D.C. 327, 239 F.2d 948, 1957 C.D. 51, 714 O.G. 4, 111 USPQ 325.

The decision of the examiner is affirmed.

A new rejection is made under the provisions of Rule 196(b).

Any request for rehearing or reconsideration or modification of this decision by the Board of Appeals based upon the same record must be filed within thirty days from the date of the decision. (Rule 197). Should

appellants elect to have further prosecution before the examiner in response to the new rejection under Rule 196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire *thirty days* from the date of this decision.

Patent Office Board of Patent Interferences

NERWIN v. ERlichman

Decided May 29, 1969

PATENTS

1. Interference — Interference in fact (\$41.40)

Interference — Issues determined (\$41.45)

Since interference party in opposition to opponents's motion to amend by adding counts did not raise issue of no interference in fact because of improper modification of patent claims in counts, that issue as raised for first time in party's brief will not be considered; had party raised issue before primary examiner in opposing motion, either opponent or examiner might have cited prior art to show lack of patentable distinction between patent claims and counts.

2. Interference — Interference in fact (\$41.40)

Demonstration by mere comparison that patent claim and count consisting of broadened modification of patent claim recite distinct or different inventions in sense of *Brailsford v. Lavet*, 138 USPQ 28, is not determinative of issue as to whether patent claim and count are directed to same invention; upon such demonstration there would remain the question whether in view of pertinent prior art the substance of count makes obvious to one ordinarily skilled in the art the substance of patent claim, or vice versa.

3. Interference — Issues determined (\$41.45)

Issues of lack of support for counts are not considered where they were raised for first time in briefs at final hearing.

4. Patentability — Divided and integral parts (§51.35)

Fact that a structure is integral does not preclude its consisting of various elements.

Patent interference No. 95,697 between Nerwin and Erlichman. Priority awarded to Erlichman.

Before BOYS and CAPELLI, Examiners of Interferences, and ROEMING, Acting Examiner of Interferences.

ROEMING, Acting Examiner of Interferences.

The counts of this interference relate to a non-camera photographic apparatus and also to a camera.

The interference involves the reissue application of the senior party Erlichman and the patent of the junior party Nerwin. Counts 1 through 5 are claims of the Nerwin patent; counts 6 through 12 are modified claims of the patent.

The specification and drawings of the Erlichman reissue application are identical with those of the patent proposed to be reissued.

No testimony was taken. Only Erlichman filed preliminary statements. Nerwin timely moved to dissolve as to the original count on the ground of lack of support in Erlichman's disclosure. Erlichman opposed. Erlichman moved to amend by adding counts. Nerwin opposed the addition only on the ground of lack of support in Erlichman's disclosure. The Primary Examiner denied the motion to dissolve and granted in part the motion to amend. Nerwin requested final hearing for review of the issues raised by his motion to dissolve and his opposition to the motion to amend.

[1] Since Nerwin in his opposition to Erlichman's motion to amend did not raise the issue of no interference in fact because of improper modification of the patent claims in counts 6 through 12, that issue as raised for the first time in Nerwin's brief at final hearing will not be here considered. As to

[2] whether or not a patent claim and a count consisting of a broadened modification of the patent claim are directed to the same invention, it would not be determinative of the issue to demonstrate by mere comparison that the count and the patent claim recite distinct or different inventions in the sense of *Brailsford v. Lavet et al.*, 50 CCPA 1367, 318 F.2d 942, 796 O.G. 311, 1963 C.D. 723, 138 USPQ 28. Upon such demonstration there would remain the ques-

tion whether or not in view of pertinent prior art the substance of the count makes obvious to one ordinarily skilled in the art the substance of the patent claim, or *vice versa*. Had Nerwin raised the issue of no interference in fact before the Primary Examiner in opposing the motion to amend, either Erlichman or the Primary Examiner might have, if necessary, cited prior art to show lack of *patentable distinction* between the patent claims and the respective counts. See *In re Wagenhorst*, 20 CCPA 829, 62 F.2d 831, 431 O.G. 532, 1933 C.D. 173, 16 USPQ 126; *In re Hidy*, 49 CCPA 1152, 303 F.2d 954, 782 O.G. 16, 1962 C.D. 380, 133 USPQ 650; *In re Ellis et al.*, 47 F.2d 963, 409 O.G. 559, 1931 C.D. 330, 8 USPQ 489, and *In re Risse et al.*, 54 CCPA 1495, 378 F.2d 948, 154 USPQ 1. Since neither Erlichman nor the Primary Examiner had the opportunity to cite prior art on this issue when Erlichman moved to add the counts which became counts 6 through 12, the issue of no interference in fact as now belatedly presented is not shown to be completely developed. Accordingly, any consideration of it here would be pointless.

[3] The only issues here to be determined are those specific issues of alleged Erlichman lack of count support which were raised by Nerwin before the Primary Examiner on the parties' motions, namely in Papers Nos. 8, 13 and 14 of the interference file. Those specific issues of lack of support raised for the first time in Nerwin's briefs at final hearing will not be here considered. *Smith et al. v. Klemperer* (Board of Interference Examiners 1949), 103 USPQ 275, and the court cases therein cited.

As to count 1, at page 1 of his reply brief Nerwin admits that the use limitations in the preamble are supported by Erlichman's Figure 10.

In issue is Erlichman's right to make in count 1 the limitations (1) "a divider between said exposure and processing chamber" and (2) "means effective upon movement of said strip along said first path for denoting the leading edge of each said sheet along a second path branching from said first path.*** into said exposure chamber."

Nerwin in effect contends that these limitations set forth two separate elements, that he discloses a divider comprising the roller 44 and the wall 34, that in his disclosure "the directing means comprises strip-per 43," that in Erlichman's disclosure of Figure 10 these limitations find support only in the structure 198, that that structure is a single element, and that Erlichman may not use this single element to meet two

positively stated and separately claimed elements of the count." Erlichman cites *In re Kelley*, 49 CCPA 1259, 305 F.2d 909, 785 O.G. 413, 1962 C.D. 681, 134 USPQ 397, as authority that said limitations are properly supported by his structure 198. He further asserts and Nerwin does not deny that these limitations are unambiguous. Erlichman correctly notes that in Nerwin's patent the roller 44 is not only the divider but is also part of the "means * * * for pressing said layers toward one another." Nerwin's specification states as to his element 43:

"* * * To assist in directing the free end of the sheets into the exposure chamber a thin *stripper* member 43 of resilient material may be provided, so arranged as to bear lightly against the roll of film material in the supply chamber * * *." [Emphasis added.]

The emphasized terms in the foregoing statement indicate that the *stripper* member 43 is not per se the entire means for "directing" the sheet into the exposure chamber. The roller 44 clearly participates also in that function. Nerwin states:

"* * * In Figure 10 of the Erlichman disclosure, the only structure conceivably forming such a divider is guide member 198. How guide member 198 functions as a divider is not clear since there is essentially a direct path from exposure chamber 184 to processing chamber 196 of Erlichman * * *"

Neither Nerwin nor Erlichman uses the term "divider" or expressly refers to, a dividing function in his specification. In any event, it is clear that the tip of Erlichman's member 198 interposes itself between the strip and the sheet in the same manner as does Nerwin's roller 44, thus to divide the paths of the strip and the sheet.

[4] The mere fact that a given structure is integral does not preclude its consisting of various elements. In *Howard et al. v. Detroit Stove Works*, 150 U.S. 164, 65 O.G. 1765, 1893 C.D. 659, the Supreme Court pertinently stated:

"* * * the Monumental grate * * * contains all the *elements* of the Beckwith grate, except that * * * it is cast in two pieces, while the Beckwith grate is cast in one piece." [Emphasis added.]

In *Reed v. Edwards*, 26 CCPA 901, 101 F.2d 550, 505 O.G. 234, 1939 C.D. 291, 40 USPQ 620, the court stated:

"* * * with reference to the statement [of the Board of Appeals] that the same element may be relied upon for perform-

ing two functions, we express no opinion thereon with respect to the application of that rule as applied to the counts before us. We are of the opinion, however, that while a given structure may in one sense be considered a single element, in another sense it may be so formed as to consist of several elements depending upon the functions to the performed by such elements."

If the upper portion of Erlichman's member 198 were eliminated and the "divider" tip of member 198 were supported by a member extending horizontally directly to the outer wall of chamber 196, then after the dividing of the paths of the sheet and of the strip, the sheet would not be guided into the exposure chamber 184. Clearly the upper portion of Erlichman's member 198 is an element which performs a function distinct from the dividing function of the tip, namely the function of assisting in guiding the sheet into the exposure chamber. Moreover, as Erlichman correctly points out, the curved surface joining the wall 188 of his exposure chamber and the top wall of his supply chamber cooperates in bending and guiding the sheet into the exposure chamber. We find it unnecessary to rely on *In re Kelley*, supra. In analogy to the findings in *Reed v. Edwards*, supra, and *Holsworth v. Goldsmith*, 29 CCPA 1047, 129 F.2d 571, 542 O.G. 791, 1942 C.D. 491, 54 USPQ 90, we find that Erlichman supports the above indicated limitations of count 1 without double reading on the same element or structure. Moreover, we find that for support of these limitations Erlichman relies on "double reading" no more than does Nerwin.

Also in issue is Erlichman's right to make in count 1 the limitation: "said divider being effective upon continued movement of said strip * * * to cause such sheet to be effectively pulled * * * back past said divider and through said processing chamber in inverted position on said strip with said photosensitive and image-receptive layers facing one another." Nerwin contends that in Erlichman, the "inversion takes place in the initial movement of the strip by which the photosensitive sheet 164 branches into exposure chamber 184." When Erlichman's sheet is located in the exposure chamber there clearly is no completed inversion of the sheet, and the photosensitive and image-receptive layers do not face one another. On the continued movement of the strip, the sheet is clearly pulled back past the divider, the inversion is completed, and the said layers are brought into position to face one another.

We conclude that count 1 is supported by the disclosure of Erlichman's Figure 10.

In Nerwin's opposition to Erlichman's motion to amend (Paper No. 13) the only issue of alleged Erlichman lack of support as to counts 2 through 12 (proposed counts *j* through *s* and *v* of the motion to amend) is raised as follows:

"Proposed count *j* also provides that continued movement of the strip in the same direction causes the sheet to be effectively inverted, and as stated above, the disclosure of the party Erlichman only shows inversion to take place upon initial movement into the sheet receiving chamber and not upon continued movement thereafter. Proposed counts *k*, *l* and *m* each are dependent upon proposed count *j*.

"Finally, it is respectfully submitted that the motions in the alternative to add counts *n* through *v* should be denied, because the party Erlichman has failed to show error to permit a reissue application, and particularly in regard to proposed counts *p* through *w*, the Erlichman disclosure does not support the elements of the counts regarding inversion after exposure for the reasons stated above and the Motion to Dissolve filed by the party Nerwin."

There is nothing in the terminology of any of counts 2 through 12 which makes the foregoing statement any more persuasive as to these counts than was its equivalent with respect to the corresponding substance of count 1. We find that the disclosure of Erlichman's Figure 10 supports counts 2 through 12.

In his brief, Erlichman alleges support in his structure of Figure 11 for counts 6 through 12. In Erlichman's motion to amend, the allusions to Figure 11 are too vague and their pertinence to specific counts and specific limitations is not sufficiently demonstrated to raise issues which are properly before us for review.

In summary, we find that Erlichman has established the earlier date of invention and that his reissue application disclosure supports all the counts.

Priority of invention of the subject matter in issue is awarded to Irving Erlichman, the senior party.

Patent Office Trademark Trial and Appeal Board

In re FIRST NATIONAL CITY BANK

Decided Dec. 21, 1970

TRADEMARKS

1. Marks and names subject to ownership — In general (§67.501)

Title of series of annually distributed record albums may be registered as trademark.

2. Title — In general (§67.861)

Trademark need not be used in association with name of its owner whether owner personally produces and sells goods or they are produced and/or marketed for his benefit by a person in privity with him.

Appeal from Examiner of Trademarks.

Application for registration of trademark of First National City Bank, Serial No. 315,902. From decision refusing registration, applicant appeals. Reversed.

KENYON & KENYON, REILLY, CARR & CHAPIN, New York, N. Y., for applicant.

Before LEACH, WALDSTREICHER, and LEFKOWITZ, Members.

WALDSTREICHER, Member.

First National City Bank filed an application on January 6, 1969 to register "CHRISTMAS IN NEW YORK" for phonograph record albums. Use since October 23, 1967 is alleged.

Registration has been refused on the ground that "CHRISTMAS IN NEW YORK" does not function as a trademark for phonograph record albums. Registration was further refused on the ground that applicant is not the owner of the "alleged" trademark.

Applicant has appealed.

The specimens presented show "CHRISTMAS IN NEW YORK" used as a "title" of a record album but it does not appear that it is a title of any of the songs recorded for playback. The specimens do not disclose applicant's name but the album jackets and the record labels display the marks "RCA" and "RCA VICTOR" and the tradename "RCA Corporation."

It seems to be the examiner's position that since "CHRISTMAS IN NEW YORK" is the title of the record album, it necessarily cannot function as a trademark notwithstanding that the record albums